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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,506

04/04/2006

Peter James Branton

RD 446

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22884

7590

04/27/2010

MIDDLETON & REUTLINGER

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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

04/27/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,506	<b>Applicant(s)</b> BRANTON ET AL.	
	<b>Examiner</b> CARLOS LOPEZ	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 41-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-56, 58-61 and 63-75 is/are rejected.
- 7) ☒ Claim(s) 57 and 62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

After further consideration, the restriction requirement mailed on 9/30/08 by Examiner Felton has been withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 67 and 70 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 67 depends on cancelled claim 4. For examination purposes, claim 67 will be read as limiting the plug to cellulose acetate, plastic or metal.

The phrase "said at least additional portion" in claim 70 lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-56, 58-61, 63-69, 71-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0664964 ('964) in view of Crellin et al (US 3,894,545). Figure 4 of '964 discloses a smoke filter comprising the following: a first portion 19 being closed by barrier 21, a second portion 40 allowing smoke to pass through (See Page 5, lines 40-

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41 of '964), and the first and second portion being separated by barrier 100 that is permeable to vapor phase of the tobacco smoke to prevent contamination of the adsorbent material forming first portion 19 (See Page 5, lines 37). '964 is silent disclosing the pore size of the barrier that allows the vapor phase of the tobacco smoke into first portion 19. However, as noted by Crellin the purposes of providing a barrier between a first and second portion is to prevent smoke particles from contaminating the adsorbent material (carbon) of the first portion. (See Crellin Col. 2, lines 14-20)

In view that the prior art uses a barrier to block smoke particles from contacting the first portion, it would have been obvious to a person of ordinary skill in the art to have conducted routine experimentation to determine the pore size of barrier 100 in order to allow the vapor component of the tobacco smoke to be filter by the first portion but to exclude particles in the tobacco smoke that contaminate the filter material of the first portion. Consequently, the claimed pore size of barrier 100 would have been within the grasp of a person of ordinary skill in the art that would have been arrived by routine experimentation.

As for claims 42, see above.

As for claims 43-44, the wrapper as taught by Crellin in Col. 1, lines 65-68, the barrier is formed of cellulose acetate which is flexible.

As for claims 45-48, the absorbent used is granular carbon. (See Crellin Col. 3, lines 1-5)

As for claims claim 49-55, it is obvious to substitute a general adsorbent such as carbon with more selective adsorbent in combination with catalyst in order to reduce any impact it may have the flavor of the cigarette.

As for claims 58-59, second portion of '964 is made of cellulose acetate.

As for claims 60-61, see figure 4 of '964 showing the claimed arrangement.

As for claims 63-64, the first portion of '964 is a single piece, making the single piece into separable part as required by claim 62 would have been obvious to a person of ordinary skill in the art because it would still provide a filter of the tobacco smoke.

As for claims 65-67, the closed portion is formed by barrier 21 of '964 in order to prevent the flow of smoke which would indicate materials such as plastic, metal or cellulose acetate to form a high pressure drop would be used.

As for claims 56, 68-69, the claimed additional portion is deemed as tipping paper 30 shown in figure 4.

As for claim 70, see above referring to the claimed additional portion as barrier 21.

As for claim 71, tipping paper is conventionally made of cellulose acetate.

As for claim 72, see figure 4 showing tobacco rod 20.

As for claims 73-75, smoking material conventionally includes flavorants in encapsulated or free form.

***Allowable Subject Matter***

Claims 57 and 62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LOPEZ whose telephone number is (571)272-1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos Lopez/  
Primary Examiner  
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